

REMARKS

The Office Action dated July 26, 2006, and the Advisory Action dated November 21, 2006, have been received and carefully noted. A full and complete response was filed October 26, 2006, (“the Response”) and entry and consideration of the Response has been requested by the accompanying Request for Continued Examination (RCE).

Introduction

Claims 16-20 have been added to more particularly point out and distinctly claim the invention. No new matter has been added. The amendment has been shown taking the amendments in the Response as already entered. As amended hereby, claims 1-20 are currently pending in the application, of which claims 1, 9, 11-13, and 15 are independent. Claims 1-20 are respectfully submitted for consideration in view of the remarks in the Response. The following remarks are submitted as a supplement thereto, and highlight some clear errors present in the Office Action and/or Advisory Action, as well as the features of the newly added claims.

Dots are Not Functionally Equivalent to Dashes in the Relevant Art

The Advisory Action referenced the simple experiments set forth in the Response, but nevertheless maintained the clearly erroneous position that dots are functionally equivalent to dashes. Applicants respectfully submit that the simple experiments set forth in the Response, undeniably establish the non-interchangeability of dots and dashes in the

field of Internet domain names. The Response, at page 13, line 16, to page 17, line 2, sets forth clearly a rebuttal of the Office Action's position.

The Advisory Action did not dispute the validity or relevance of the experiments, and did not even dispute the conclusion that "dots and dashes are not functionally equivalent" within the art.

Applicants respectfully submit that the experimental evidence, which clearly and unequivocally shows the lack of functional equivalence between dots and dashes in the relevant art, rebuts the Office Action's (and Advisory's Action's) bare un-evidenced and unsupported allegation that "the choice of dots or dashes is ... a design choice."

The simple fact is that, in the field of Internet domain names, dots and dashes are not functionally equivalent. If the rejection is to be maintained, Applicants respectfully request that the Examiner provide evidence of the alleged interchangeability between dots and dashes in the field of Internet domain names. In the absence of such evidence, Applicants respectfully submit that the rejection cannot properly be maintained, and its withdrawal is respectfully requested.

"Conditionally Converting" is Definite and not Optionally Recited

The Response, at page 9, line 9, to page 10, line 8, fully explains why the phrase is definite. The Advisory Action, rather than addressing the arguments set forth in the response, simply reasserts the same mistaken conclusion that the phrase is indefinite.

The USPTO is reminded that if a rejection is maintained the substance of Applicants' arguments must be addressed, as set forth in MPEP 707.07(f).

Furthermore, Applicants respectfully point out that three issued patents use the term "conditionally converting" in the claims (U.S. Patents No. 6,944,822, No. 5,771,387, and No. 5,560,012). Likewise, over 1200 issued patents use the term "conditionally" in the claims. Accordingly, there is more than sufficient evidence that the USPTO generally considers "conditionally" and "conditionally converting" to be definite.

Moreover, the Advisory Action's reliance on MPEP 2106(II)(C) is clearly mistaken. MPEP 2106, in the referenced portion, is stating that optional language is not limiting, not that it is indefinite. Accordingly, there is no legal basis for the Office Action's assertion of indefiniteness based on alleged optional character. Whether the claim is definite and whether the claim recites features in an optional matter are two separate and distinct issues.

Furthermore, the alleged optional character of the claim feature is also clearly mistaken. The Response, at page 17, lines 3-17, clearly explains why. The feature has not been recited in an optional way, nor in one of the ways described in MPEP 2106 or 2111 that allegedly give rise to a question about whether the claim language is limiting. Accordingly, the claims are both definite, and presented without the use of optional language. Indeed, under the MPEP's guidelines, the language of the claims does not even raise a question as to whether the claim language is limiting.

A Cardinal (Counting) Number is not a Size

The Advisory Action continues to maintain that “wherein the predetermined number of labels is three” is a size. This is clearly erroneous. A full rebuttal of this position is presented in the Response at page 17, line 18, to page 20, line 2.

The Advisory Action took the position that “the question “how many” can be answered with a size.” This is clearly erroneous. To take an easily understood example, if Jane has five apples, and gives three apples to Spot, the answer to the question “how many apples does Jane have” is not a size, or dimension, but is a cardinal or counting number. In this case the number is two. The number does not convey dimensionality, but simply “count.” It tells one how many apples Jane has, but not whether those apples are big or small. Accordingly, the fact that the question “how many” is answered by the cardinal number does not establish that size is being addressed.

Instead, the correct question to ask for size is “how big?” not “how many?”. The answer to the question, “how big?”, cannot be simply a number, but a number plus a dimension. Thus, the answer to “how big is the particle?” cannot be “three” but it could be “three microns.” Thus, “three” is a counting number for the count of labels, not a size or dimension of the labels.

Furthermore, the Advisory Action mistakenly characterizes the case law. In the case law, size refers to physical (*i.e.* spatial) dimensions. However, the claim limitation

in question is clearly not a physical or spatial dimension. Accordingly, the cited case law is not germane.

The Advisory Action acknowledged that the case law is not directed to a computer medium, but asserted that “the principle still applies.” However, the Advisory Action failed to identify what “the principle” behind the case law was. The principle behind the case law was that changes in physical dimension are obvious in certain factual scenarios.

Furthermore, even if the number of labels were a size, a difference in size is not automatically obvious. The CCPA (the Federal Circuit’s predecessor court), in *In re Ehrreich*, 200 USPQ 504 (CCPA 1979) found that the difference in the size of the particles was non-obvious over the cited references. *See, In re Ehrreich*, at 510 (indicating that the “combination … would not have rendered obvious the particle size limitation”). Thus, there is no *per se* rule that changes limitations relating to size are obvious.

Likewise, the Advisory Action asserted that “Paragraph [0033] of Kim et al. gives an example of a name address as “#042-123-4567”.” Applicants respectfully note that the Advisory Action was probably referring to paragraph [0034], which states that “the name address using the [telephone] number can be expressed into … #042-123-4567....” The Advisory Action asserted that this is evidence that it would have been obvious to one of ordinary skill in the art to simply change the number of labels. However, Applicants respectfully note that what is claimed is not “changing the number of labels.” Instead, the claim limitation is “wherein the predetermined number of labels is three.”

Accordingly, the Advisory Action’s argument is not directed to what is claimed, and therefore does not establish obviousness.

There is No Motivation to Combine Kim with Khello

The Response, at page 21, line 12, to page 22, line 9, fully explains that there is no motivation to combine Kim with Khello. The Advisory Action does not address the arguments set forth in the Response. The USPTO is reminded that if this rejection is maintained, the substance of the argument presented by Applicants should be answered, as set forth in MPEP 707.07(f).

Instead of answering the arguments presented, the Advisory Action recites form paragraph 7.37.04 from MPEP 707.07(f), which explains the condition in which a combination is properly suggested.

However, as that form paragraph and MPEP 2143.01 indicate, “obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.” The Advisory Action asserted that the proposed motivation is found in Khello, at paragraph [0054].

However, as noted in the Response, the discussion in paragraph [0054] is a motivation to employ Khello’s invention itself, not a motivation to combine Khello’s invention with that of Kim. Neither the Advisory Action nor the Office Action explain

how Khello's comment that "the present invention may be used [for various applications]" would teach, motivate, or suggest to one of ordinary skill in the art to combine the teachings of Khello with those of Kim. Thus, it is respectfully submitted that a *prima facie* case of obviousness has not been established.

Kim and Khello are not from the "Same Field of Endeavor"

as the Present Application

MPEP 2141.01(a)(I) states: "TO RELY ON A REFERENCE UNDER 35 U.S.C. 103, IT MUST BE ANALOGOUS PRIOR ART" (capital letters in original). Furthermore, the same section continues, by explaining that "The examiner must determine what is "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). *See also In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem."); *Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir.

1993); and *State Contracting & Eng'g Corp. v. Condotte America, Inc.*, 346 F.3d 1057, 1069, 68 USPQ2d 1481, 1490 (Fed. Cir. 2003) (where the general scope of a reference is outside the pertinent field of endeavor, the reference may be considered analogous art if subject matter disclosed therein is relevant to the particular problem with which the inventor is involved).” The Advisory Action correctly recognized this test, and asserted that “both references are in applicant’s [sic] field of endeavor.”

Applicants respectfully disagree. The field of the invention provided in the application is: “More specifically … improving the performance of current de-facto DNS name servers,” according to the present application, at paragraph [0001]. As further explained at paragraph [0006] of the present application, “Current de-facto DNS servers are based on [BIND] implementation, where the database is based on a Red-Black binary tree. A drawback related to these servers is that their performance is not optimized for the ENUM system [and] the … conversion of the telephone number into the FQDN degrades their performance.” The cited art is not related to this field of endeavor. If the rejection is maintained, it is respectfully requested that the Office Action explain the way in which the cited references address this problem, as explained above and as set forth in the Response at page 22, line 5 *et seq.*

Without such explanation, Applicants respectfully submit that the Office Action does not provide a *prima facie* case of obviousness, because obviousness must be established by evidence, not bare assertion. Accordingly, it is respectfully requested that the rejection be withdrawn.

Furthermore, even if the references were from the same field of endeavor (which has not been shown by evidence), that would not end the analysis. The mere fact that references are from “the same field of endeavor” is not, by itself, sufficient to motivate the combination of particular teachings of the references. Moreover, as explained in MPEP 2141.01(a)(V), when the technical solutions are radically different and inconsistent as they were in *Wang Laboratories, Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993), the references cannot fairly be said to be in the “same field of endeavor.” Here, the approaches of the various references are incompatible and inconsistent and therefore cannot be said to be from the same field of endeavor. Accordingly, for this additional reason, it is respectfully requested that the rejection be withdrawn.

Newly Added Claims

The newly added claims 16-20 depend respectively from claims 1, 9, 11, 13, and 15. Thus, newly added claims 16-20 are patentable for at least the reasons that claims 1, 9, 11, and 13 are patentable, as set forth in the Response. Furthermore, claims 16-20 recite features relating to enhancing the performance of a domain name system: “wherein the method is configured to enhance database performance in a domain name system” (claim 16), “wherein the system comprises fourth means for enhancing the performance of a domain name system” (claim 17), “wherein the name server is configured to provide enhanced performance for a domain name system” (claim 18), “wherein the system is

configured to provide enhanced performance for a domain name system" (claim 19), and "wherein the name server further comprises enhancement means for enhancing the performance of a domain name system" (claim 20).

As noted above, the cited references do not contain such features, as the cited references are not addressed to the issue of enhancing the performance of a domain name system, but rather are addressed to other issues. Accordingly, for this additional reason, the combination of Kim and Khello cannot disclose or suggest all of the elements of claims 16-20.

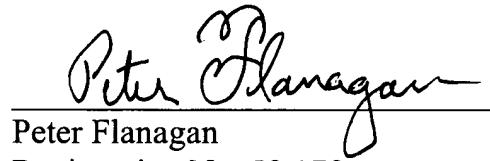
Conclusion

For the reasons explained above and set forth more fully in the Response, it is respectfully submitted that all of claims 1-20 recite subject matter that is neither disclosed nor suggested in the cited art. It is, therefore, respectfully requested that all of claims 1-20 be allowed, and that this application be passed to issue.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, Applicant's undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, Applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,


Peter Flanagan
Registration No. 58,178

Customer No. 32294
SQUIRE, SANDERS & DEMPSEY LLP
14TH Floor
8000 Towers Crescent Drive
Tysons Corner, Virginia 22182-2700
Telephone: 703-720-7800
Fax: 703-720-7802

PCF/kzw

Enclosures: Request for Continued Examination (RCE)
Petition for Two-Month Extension of Time